

Application No.: 10/667,513**Docket No.: 4459-131****REMARKS**

Claims 1-15 and 22-26 are pending in the application. The claims remain unchanged notwithstanding the Examiner's new grounds of rejection.

The finality of the Office Action mailed June 14, 2005 is deemed premature and should be withdrawn. In particular, the Examiner's new ground of rejection raised against claim 10 was not necessitated by Applicant's amendments.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP, section 706.07(a) (emphasis added).

In this particular case, claim 10 was not amended by the May 23, 2005 Amendment. Nevertheless, the Examiner raised a new ground of rejection against claim 10 in the June 14, 2005 Office Action. Apparently, the new ground of rejection against claim 10 was not necessitated by the May 23, 2005 Amendment. Therefore, the June 14, 2005 Office Action should not be made final.

Additionally, the new ground of rejection against original claim 10 is based on references that were discovered by the Examiner and are not information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Therefore, the June 14, 2005 Office Action should not be made final.

For the above advanced reasons, withdrawal of the finality of the June 14, 2005 Office Action is in order.

The new grounds of rejection against all pending claims are traversed, because the teaching

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reference of *Liu et al.* (U.S. Patent Application Publication No. 2004/0150411) is not prior art. The earliest effective reference date of *Liu et al.* is its 35 U.S.C. 102(e) date of January 30, 2003. However, this reference date postdates the earliest claimed priority date of the instant application, i.e., October 9, 2002. Therefore, the *Liu et al.* reference is not prior art and cannot be applied against the claims of the instant application. The new grounds of rejection are absolutely improper and should be withdrawn.

Notwithstanding the above, Applicants will proceed with their remarks regarding the deficiencies of the primary reference of *Buie* (U.S. Patent No. 3,768,157).

With regard to Claim 1:

Claim 1 recites an impedance standard substrate for calibrating a vector network analyzer, said vector network analyzer including two probes, said impedance standard substrate comprising: a first surface; a second surface opposite to the first surface; and a thru-circuit having two contacts electrically connected to each other and respectively disposed on the first surface and the second surface, wherein the contacts are adapted to electrically connect to the probes. The claimed invention is characterized in that the impedance standard substrate is adapted to calibrate a vector network analyzer, and the thru-circuit has two contacts electrically connected to each other.

However, as shown in FIG. 4b, *Buie* only discloses a process of resistor adjustment and semiconductor microelectronic device package, wherein the package comprises a base member 13 for accommodating a chip 10. Thus, the base member 13 of *Buie* is distinctly different from the claimed impedance standard substrate for calibrating a vector network analyzer. Furthermore, as shown in FIG 4b, *Buie* discloses that the chip 10 is attached to the base element 13, the fingers and the chip 10 cannot form a thru-circuit. Thus, *Buie* fails to disclose or suggest that the thru-circuit has two contacts electrically connected to each other.

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Thus, *Buie* and singly or in combination with other cited references fails to anticipate or render the claimed invention obvious, because the base member 13 of *Buie* is distinctly different from the impedance standard substrate of the claimed invention, and *Buie* fails to disclose the thru-circuit of the claimed invention.

Accordingly, claim 1 is distinctly different from and non-obvious over *Buie* and other cited references.

With regard to claims 2-9 and 22:

Claims 2-9 and 22 depend from claim 1, and are considered patentable at least for the reason advanced with respect to claim 1.

With regard to claim 10:

Claim 10 is considered patentable at least for the similar reason advanced with respect to claim 1.

With regard to claims 11-15 and 23-25:

Claims 11-15 and 23-25 depend from claim 10, and are considered patentable at least for the reason advanced with respect to claim 10.

With regard to claims 7-9 and 11-13 rejected under 35 U.S.C. 103(a) as being unpatentable over *Buie* (U.S. Patent No. 3,768,157) in view of *Liu et al.* (U.S. Publication No. 2004/0150411 A1) in view of *Dunsmore* (U.S. Patent No. 6,643,597):

Claims 7 and 11 recite the impedance standard substrate further comprising a pair of open-circuits disposed on the first surface and the second surface, respectively. Claims 8 and 12 recite the impedance standard substrate further comprising a pair of short-circuits disposed on the first

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surface and the second surface, respectively. Claims 9 and 13 recite the impedance standard substrate further comprising a pair of load-circuits disposed on the first surface and the second surface, respectively.

However, *Buie* only discloses that the package comprises a base member 13 for accommodating a chip 10 (e.g. shown in FIG. 4b), and *Dunsmore* only discloses a short model 230, an open model 240 and a load model 250 according to a method for calibrating a test system (e.g. disclosed in col. 8, line 41 to col. 9 line 2; col. 10, lines 26-58; col. 10, line 59 to col. 11, line 29; and col. 11, lines 30-56).

According to MPEP, Section 2143, "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

For present case, there is no suggestion or motivation to modify the *Buie* reference or to combine the teachings of *Buie* and *Dunsmore*, because the base member of *Buie* is used for accommodating a chip 10, rather for calibrating a test system. Furthermore, *Buie* and *Dunsmore* are not combinable absent some reasonable expectation of success.

Thus, *Buie* and *Dunsmore* singly or in combination fail to render the claimed invention obvious. Accordingly, claims 7-9 and 11-13 are distinctly different from and non-obvious over the cited references of *Buie* and *Dunsmore*.

Accordingly, all claims in the present application are believed in condition for allowance and early and favorable indication of same is courteously solicited.

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The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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